

REMARKSProcedural Status

A summary of particular, but not all events, in the file history is as follows.

The present application was filed October 20, 2001 as a continuation-in-part of a prior application.

A preliminary amendment was filed April 18, 2001. The amendment withdraw all of the claims (which were duplicates of claims that had been pending in a related application) and introduced an entirely new set of claims directed to different inventions than those claimed. In this regard, the amendment was not narrowing, and should not be viewed or examined as such.

In response to a restriction requirement mailed April 21, 2003, noting that the new set of claims contained patentably distinct inventions, the applicant elected claims 75-112.

An office action rejecting claims 75-112 was mailed June 19, 2003.

The undersigned and the Examiner conducted a telephone interview on September 25, 2003. During the interview, the undersigned presented the arguments below. The Examiner indicated his preliminary view that the arguments appeared to make a *prima facie* case of patentability over the cited references. However, the Examiner requested that the arguments be provided in writing so that they could be more fully considered.

The instant remarks are responsive to the office action dated June 19, 2003 and September 25, 2003 interview. An extension of time to respond to the office action is included and requested herein.

Drawings

The Examiner objected to the informal drawings based on number of informalities. New formal drawings are filed contemporaneously herewith.

Claims - Generally

The Examiner has initially rejected many of the claims based on *Mellgren III*, U.S. Patent No. 6,085,126, either alone or in combination with *Barnes*, U.S. Patent No. 5,970,475, or *Farros*, U.S. Patent No. 5,930,810. Some of the rejections were based on *Barnes* alone. However, as set forth below, all of the claims are novel and non-obvious with respect to these references.

Claim 75, 102 and 111

Claims 75, 102 and 111 have all been amended to include the element of receiving login information from a first and second user, wherein the login information is different for each user and impacts the ability to change the personalization information.

Claim 75 relates to a method of "obtaining information about a personalized product to be provided from a provider to an organization." As noted in the preamble, "the personalized product display[s] information."

As amended, the method includes the step of receiving login information identifying a first user within the organization. The first user transmits instructions, over a network, that define "which aspects of the information have values which may be changed by a second user within the organization such that the instructions define at least one aspect which may be changed and at least one aspect which may not be changed."

The method transmits "the values of aspects" over the network to the second user along with an "indication in accordance with the instructions". The indication distinguishes between those "aspects which the second user may change from those which the second user may not change."

The method, as amended, also recites the step of receiving login information from a second user within the

organization that is different from the login information of the first user. Moreover, the claim has further been amended to recite that the second user's login information, in addition to the information received from the first user, is used as a basis for distinguishing the aspects which the second user may change from those which the second user may not change.

Finally, the method includes receiving, from the second user, "the value of an aspect which may be changed in accordance with the instructions and which has changed from the transmitted value."

Although *Mellgren* teaches the use of two computers in connection with ordering engravable media, it does not teach the elements of amended claim 75. For example, the abstract of *Mellgren* states:

A system for creating and ordering custom designed imprintable media. The system includes a one or more first computers coupled to a central computer. The first computers are configured and arranged to input a type indicating one of a plurality of imprintable media, custom design information to engrave on an imprintable medium of the type input, and order information, and to display an image of the custom design to appear on the imprintable medium. Example custom design information includes text, clip-art, and size and shape of the imprintable medium. Custom designs and orders are automatically transmitted to a second computer for order processing.

*Mellgren*, Abstract (emphasis added). The abstract merely states that a first computer is used to enter in the information to be engraved on a media and the second computer is used to receive the order. The Examiner also cited Figures 3-20 in support, but Figure 3 similarly shows a first computer being used to input a custom design and a second computer being used to receive the

order in step 318. The specification of *Mellgren* makes it even clearer that the second computer is being used for the purpose of ordering a product in accordance with the customization information provided by the first computer:

In the example embodiment, central computer system 106 establishes communication with kiosk 102 via modem. Under control of central computer system 106, the custom design and order information (for example, the codes) is transmitted from kiosk 102 to central computer system 106, as shown by step 318.

*Mellgren* at col. 5, lns. 56-58.

Thus, while one of the two computers of *Mellgren* (the kiosk) allows customization of products, the other computer orders the product based on the provided customizations. The two computers of *Mellgren* thus differ from the invention of claim 75. Moreover, there is clearly no teaching in *Mellgren* that the kiosk and central computer system login in using different login information. In addition, there is clearly no teaching of transmitting an indication of what aspects of personalization information can and cannot be changed based on both (a) the instructions provided by a user logging in with the first login information and (b) the login information received by a second user.

For all of the foregoing reasons, allowance of claim 75 and all claims dependant thereon is respectfully requested.

Claims 102 and 111 have also been amended to recite login information. The added elements of claim 102 and 111 are not identical to the elements added to claim 75. However, as noted above, *Mellgren* still lacks login information and still teaches that one of the computers is used for ordering. Accordingly, allowance of claims 102 and 111, and the claims dependant thereon, is respectfully requested.

Claim 96

Claim 96 and all of the claims discussed below are directed towards different elements of the invention than the previously-discussed claims. In this regard, the remaining claims have not been amended. All of the claims are patentable in view of *Mellgren*.

Claim 96 recites a method of allowing a user to provide personalization information over a client/server network. The personalization information is used to personalize a product.

The first step of claim 96 requires storing information representing whether a first and second aspect of the personalization information is locked or unlocked. If the aspect is locked, then the value of the aspect may not be changed. Conversely, if the aspect is unlocked, then the value of the aspect may be changed.

According to claim 96, a web page is sent to the client describing the first and second aspect. If the aspect is locked, then the web page displays the value of the aspect. If the aspect is unlocked, then the web page indicates that the value of the aspect may be changed.

The last step of claim 96 is "receiving from the user an instruction to change the information representing whether the first aspect is locked or unlocked." This step does not recite simply receiving the information representing the value of the aspect, such as the name of a person. Rather, it states receiving an instruction from the client to change whether the aspect is locked or unlocked. As noted above, claim 96 expressly defines "unlocked" and "locked" as representing whether the value may be changed or not.

As far as the undersigned can tell, the Office Action does not appear allude to any portion of *Mellgren* which teaches this feature of receiving an instruction from the client to

change whether the aspect is locked or unlocked. Moreover, the undersigned is not aware of any portion of *Mellgren* which teaches, or even suggests, this feature.

Accordingly, allowance of claim 96 and all claims dependant thereon is respectfully requested.

Claim 103

Claim 103 provides a system of allowing a user to provide personalization information over a client/server network. The system includes means for storing information representing whether a first and second aspect of the personalization information is locked or unlocked, whereby if an aspect is locked then the value of the aspect may not be changed and if an aspect is unlocked then the value of the aspect may be changed.

Claim 103 also includes means for sending a web page to the client describing the aspects. If the aspect is locked, then the web page displays the value of the aspect. If the aspect is unlocked, then the web page indicates that the value of the aspect may be changed. Finally, the claim includes means for receiving, from the user, an instruction to change the information representing whether the first aspect is locked or unlocked.

Accordingly, claim 103 requires means for receiving, from the user, an instruction to change the information representing whether the first aspect is locked or unlocked. As noted above, *Mellgren* does not teach or suggest this element.

For all of the foregoing reasons, allowance of claim 103 is respectfully requested.

Claim 104

Claim 104 provides a method of receiving personalized information to be displayed on a product, whereby the personalization information has aspects and the aspects have values.

The first step recited in claim 104 is receiving locking instructions from a first user, whereby if the instructions identify an aspect as being locked, then the value cannot be changed until the aspect is unlocked.

The second step involves sending values of aspects to a second user, as well as indicating whether the aspect is locked. The step also requires that at least one of the aspects is locked.

Next, an instruction is received from a second user to unlock a locked aspect. The value of the prior locked aspect is then sent to the second user with an indication that the value may now be changed. Another step includes receiving the value of the prior locked aspect.

The Examiner rejected claim 104 on the basis that it was obvious in view of the combination of *Mellgren* and *Barnes*. The Examiner stated that:

*Mellgren* does not specifically disclose and teach receiving an instruction from a second user to unlock a locked aspect; resending the value of the prior locked aspect to the second user with an indication that the value may now be changed, and receiving the value of the locked aspect.

Office Action 6/19/03 at 11. The applicant agrees that *Mellgren* lacks such a teaching.

Even so, the Examiner asserts that it would be obvious to combine *Mellgren* with *Barnes*, U.S. Patent No. 5,970,475.

However, the language cited by the Examiner shows that *Barnes* expressly teaches away from being used in connection with personalization information to be displayed on a product. The Examiner cites columns 6, lines 4-65, yet that passage states:

Referring to FIG. 1, the EC System ... is primarily intended to meet the purchasing requirements of large numbers of employees/users at a buyer, purchases or

customer organization 12 who have recurrent needs to order goods and/or services. Preferably, such goods or services are standard, "non-custom" or "non-production" goods/services that might be found in and ordered from a catalog of a supplier or seller 16, such as office supplies, replacement

*Barnes* at col. 6, lns 13-22 (emphasis added).

Contrary to *Barnes*, *Mellgren* is expressly directed to ordering custom products. *Mellgren's* own abstract states: "A system for creating and ordering custom designed imprintable media." Abstract (emphasis added). This alone is sufficient to show that it is not obvious to combine the teachings of *Barnes* with the teachings of *Mellgren*. As the Federal Circuit has stated:

Prior art references may be considered to teach away when "a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant."

*Monarch Knitting Mach. Corp. v. Fukuhara Indus. & Trading Co.*, 139 F.3d 977 (Fed. Cir. 1998) (citing *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed.Cir.1994)). Clearly, one of ordinary skill in the art reading *Barnes'* teaching that it is expressly preferable for it to be used with "non-custom" goods would be led in a direction away from combination with *Mellgren's* system which is expressly directed to "custom" goods.

This distinction is also relevant to claim 104. The claim is directed "personalized information to be displayed on a product."

In addition, there is simply no suggestion or motivation to combine *Barnes* and *Mellgren*. The suggestion does not appear in either the references or the office action. As

noted in the Manual of Patent Examining Procedure (MPEP) § 706.02(j), there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Accordingly, the claimed invention is not obvious in light of the combination of *Barnes* and *Mellgren* because, among other reasons, it is not obvious to combine those references to arrive at the invention recited in claim 104.

Even if *Barnes* did not teach away from combination with *Mellgren* -- which it does -- and even if there was a suggestion to combine *Barnes* and *Mellgren* -- which there is not -- the combination still does not result in the claimed invention.

Claim 104 recites that an instruction is received from a second user to unlock a locked aspect of the personalization information. The Office Action cites column 6, lines 54-65 of *Barnes* for teaching this element. However, that section merely states that an administer may define a user profile such that the profile determines "what part of the catalog server 42 the user may view, the user's spending limits, the nature of the goods/services that the user may procure, the nature of the administrative options that the may access and execute, etc." *Barnes*, col. 61-65. Accordingly, there is no teaching of receiving a request to unlock an aspect of personalization information.

Claim 104 also recites "resending the value of the prior locked aspect to the second user with an indication that the value may now be changed." The office action cites column 6, lines 4-65 as teaching that element. However, nothing in that section of *Barnes* appears to teach sending an indication that the user is now free to change what was previously locked. Even if the user profile were considered to be an aspect of

personalization information, column 6 certainly does not teach sending an indication that the previously-locked profile information may now be changed.

Claim 104 further recites "receiving the value of the prior locked aspect." The office action relies on column 8, lines 28-35 as teaching that element. However, the most relevant part of that section simply teaches that an administrator "can set up the parameters of the user hierarchy . . . to establish which users 24 can access which portions of the Supplier's Catalog 42, 44 and other administrative functions." *Barnes*, col. 8, lns. 28-32. Thus, it does not teach receiving the value of an aspect that was previously locked from change.

For all of the foregoing reasons, allowance of claim 104 and the claims dependant thereon is respectfully requested.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

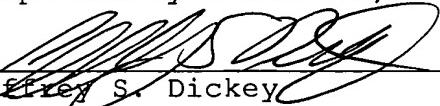
If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he/she telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: November 19, 2003

Respectfully submitted,

By

  
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